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Attorney Dkt. No. 224677US-33

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

TEQUILA CAZADORES, S.A. de C.V.,)
)
Opposer,)
)
v.)
)
TEQUILA CENTINELA, S.A. de C.V.,)
)
Applicant.)

Opposition No. 125,436
Appln. Serial No. 76/112,825
Mark: CABRITO & Design



06-19-2003

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #22

APPLICANT'S REQUEST FOR
LEAVE TO FILE SUR-REPLY

Applicant, TEQUILA CENTINELA, S.A. de C.V. ("Centinela"), herein requests leave to file its attached Sur-Reply in further opposition to the renewed motion by Bacardi & Company Limited ("Bacardi") for summary judgment. Centinela's proposed Sur-Reply is submitted solely to distinguish a recent opinion by the Board that Bacardi cited for the first time in its Reply Brief in Connection with Opposer's Motion for Summary Judgment. *Medinol Ltd. v. Neuro VASX, Inc.*, 2003 TTAB LEXIS 227 (TTAB May 13, 2003).

Applicant's counsel was not aware of the Board's *Medinol* decision until after Centinela filed its opposition to Bacardi's renewed motion for summary judgment. Applicant's counsel is mindful that Trademark Rule 2.127(a) does not allow for briefing on motions beyond the movant's reply. However, this Opposition presents the rare circumstance in which the Board should exercise its discretion to depart from the stated Rule.¹

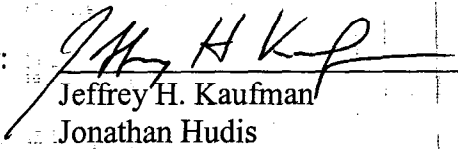
¹ When the Trademark Rules of Practice were amended in 1998, the Trademark Bar raised concerns about the Board's intended prohibitions upon a non-movant's ability to file sur-reply papers when new issues were raised by the movant for the first time in a reply brief. The Board did not agree with the Bar's concerns, and adopted the amended language of Trademark Rule 2.127(a) as it now reads. *Miscellaneous Changes to Trademark Trial and Appeal Board Rules*, 63 Fed. Reg. 48081, 48093 (September 9, 1998). The Bar's concerns have proven to be well-founded in these proceedings, and Centinela therefore requests that the Board permit the filing of Centinela's Sur-Reply.

WHEREFORE, Applicant, Tequila Centinela, S.A. de C.V., urges that its request for leave to file its Sur-Reply in further opposition to the renewed motion by Bacardi & Company Limited be granted.

Respectfully submitted,

TEQUILA CENTINELA, S.A. de C.V.

By:


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Date: June 19, 2003

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APPLICANT'S SUR-REPLY IN
FURTHER OPPOSITION TO RENEWED MOTION
BY BACARDI & COMPANY FOR SUMMARY JUDGMENT

Applicant, TEQUILA CENTINELA, S.A. de C.V. ("Centinela"), herein submits its Sur-Reply in further opposition to the renewed motion by Bacardi & Company Limited ("Bacardi") for summary judgment. This Sur-Reply is submitted solely to distinguish a recent opinion by the Board that Bacardi cited for the first time in its Reply Brief in Connection with Opposer's Motion for Summary Judgment.

The decision in question is *Medinol Ltd. v. Neuro VASX, Inc.*, 2003 TTAB LEXIS 227 (TTAB May 13, 2003). Bacardi relies on *Medinol* in urging that Centinela, during this Opposition, should not be able to amend its CABRITO & Design application to cure what Bacardi claims are fraudulent misrepresentations. The *Medinol* case is distinguishable in several respects.

In *Medinol*, long after the cancellation action had been filed accusing the registrant, Neuro VASX, Inc. ("Neuro") of fraud, Neuro moved simultaneously to amend its registration to delete the goods on which it had not used the mark and for summary judgment. *Medinol*, 2003

TTAB LEXIS 227, *3 - *6, *8. Here, before Bacardi sought to enter this Opposition, to amend the Notice of Opposition to assert fraud, and to move for summary judgment based on fraud, Centinela moved to amend its CABRITO & Design application to delete the goods on which it had not used the mark.

Neuro's motion to amend its registration and motion for summary judgment in *Medinol* were not supported by any affidavits or other evidence. *Medinol*, 2003 TTAB LEXIS 227, *7. Here, Centinela's motion to amend its CABRITO & Design application and its opposition to Bacardi's summary judgment motion of fraud were supported by detailed declarations (with supporting documentation) explaining: (i) the reasons for the errors in the application and (ii) why the amendments to the application were and are proper.

The Board in *Medinol* noted that Neuro did not seek to correct its identification of goods prior to registration or at any time prior to the filing of the cancellation petition. *Medinol*, 2003 TTAB LEXIS 227, *8, *17. Here, Centinela sought to amend its application before Bacardi introduced its proposed fraud claim and well before the issuance of any registration.

The Board also noted in *Medinol* that Neuro knowingly made a material misrepresentation to the PTO in order to obtain its trademark registration. *Medinol*, 2003 TTAB LEXIS 227, *11. As Centinela explained in its opposition to Bacardi's original and renewed summary judgment motions, the errors in the CABRITO & Design application were made because Centinela was not at the time effectively represented by U.S. counsel. Centinela at no time knowingly made a material misrepresentation to the PTO.

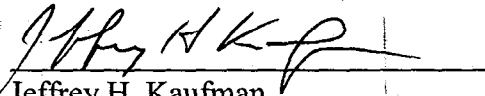
Given all the factors distinguishing *Medinol* from the present Opposition, Centinela urges that the holding of that decision should not govern, or be relied on in, these proceedings.

WHEREFORE, Applicant, Tequila Centinela, S.A. de C.V., continues its request that the renewed motion of Bacardi & Company Limited for summary judgment be denied.

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing **APPLICANT'S REQUEST FOR LEAVE TO FILE SUR-REPLY** and **APPLICANT'S SUR-REPLY IN FURTHER OPPOSITION TO RENEWED MOTION BY BACARDI & COMPANY FOR SUMMARY JUDGMENT** were served on counsel for Opposer, this 19th day of June, 2003, by sending same via First Class Mail, postage prepaid, to:

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